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APPLICATION NO.	FI	LING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,951	0	04/11/2001	John Chad Parry	262/117 769	
22249	7590	07/28/2004		EXAMINER	
LYON & LY				BASEHOAL	R, ADAM L
633 WEST F	IF IH 511	KEEI		ART UNIT	PAPER NUMBER
LOS ANGEL	ES, CA	90071		2178	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

AUG 0 9 2004

Technology Center 2100

	Application No.	Applicant(s)
	09/829,951	PARRY, JOHN CHAD
Office Action Summary	Examiner	Art Unit
	Adam L Basehoar	2178
The MAILING DATE of this communication a Period for Reply	appears on the cover sheet with the	correspondence address
A SHORTENED STATUTORY PERIOD FOR REF THE MAILING DATE OF THIS COMMUNICATION - Extensions of time may be available under the provisions of 37 CFR after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a r - If NO period for reply is specified above, the maximum statutory perion - Failure to reply within the set or extended period for reply will, by state Any reply received by the Office later than three months after the material earned patent term adjustment. See 37 CFR 1.704(b).	N. 1.136(a). In no event, however, may a reply be to the statutory minimum of thirty (30) do to will apply and will expire SIX (6) MONTHS frouture, cause the application to become ABANDON	timely filed ays will be considered timely. m the mailing date of this communication. IED (35 U.S.C. § 133).
Status		
1) Responsive to communication(s) filed on 11	April 2001.	
2a) This action is FINAL . 2b) ⊠ TI	his action is non-final.	
3) Since this application is in condition for allow closed in accordance with the practice under		
Disposition of Claims	•	
4) ☐ Claim(s) 1-29 is/are pending in the application 4a) Of the above claim(s) is/are withd 5) ☐ Claim(s) is/are allowed. 6) ☐ Claim(s) 1-29 is/are rejected. 7) ☐ Claim(s) is/are objected to. 8) ☐ Claim(s) are subject to restriction and	rawn from consideration.	
Application Papers		
9) The specification is objected to by the Exami	iner.	
10)⊠ The drawing(s) filed on 11 April 2001 is/are:	a)⊠ accepted or b)□ objected to	by the Examiner.
Applicant may not request that any objection to the		• •
Replacement drawing sheet(s) including the corr 11) The oath or declaration is objected to by the		
Priority under 35 U.S.C. § 119		
12) Acknowledgment is made of a claim for forei a) All b) Some * c) None of: 1. Certified copies of the priority docume 2. Certified copies of the priority docume 3. Copies of the certified copies of the p application from the International Burd * See the attached detailed Office action for a l	ents have been received. ents have been received in Applica riority documents have been recei eau (PCT Rule 17.2(a)).	ation No ved in this National Stage
Attachment(s)		
 Notice of References Cited (PTO-892) Notice of Draftsperson's Patent Drawing Review (PTO-948) 	4) 🔲 Interview Summa Paper No(s)/Mail	
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/Paper No(s)/Mail Date <u>06/26/01</u> .	_ ` ` ` ` `	I Patent Application (PTO-152)

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DETAILED ACTION

- 1. This action is responsive to communications: The Application filed on 04/1/01 and the IDS filed on 06/26/01.
- 2. Claims 1-29 are pending in the case. Claims 1, 18, 23, and 29 are independent claims.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No.09/829952. Although the conflicting claims are not identical, they are not patentably distinct from each other because, while the instant application does not teach a business method, it would have been obvious to one or ordinary skill in the art at

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the time of the invention to have used said method as a business method to generate a tangible profit.

5. This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
- 7. Claims 1-11, 17-20, and 23-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al (US: 6,336,116 01/01/02).
 - -In regard to independent claims 1 and 18, Brown teaches a hosted application service comprising:

providing an instruction (code)(columns 2 & 10, lines 25-28 & 10-32) to be embedded in a customer document (Fig. 8: 61) wherein said instruction retrieves hosted service information from an application service provider system (column 2, lines 29-42) (Fig. 9)

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and seamlessly integrates said information into said customer document at a user location (Fig.8: 61 & 12A-C).

-In regard to dependent claim 2, Brown teaches wherein said document does not reside on said application server (column 2, lines 9-15).

-In regard to dependent claim 3, Brown teaches wherein said application service provider includes a server (column 14-18)(Fig. 9: 66 & 4), HTML web page document (columns 8 & 10, lines 3-5 & 10-32), and a user web browser (column 8, lines 3-8).

-In regard to dependent claim 4, Brown teaches wherein said instruction retrieves hosted application service information by initiating a service resource request (search query) from said provider server (column 2, lines 29-42).

-In regard to dependent claim 5, Brown teaches wherein said instruction further directs dynamic information (search query & provider identifier information)(column 2, lines 30-36) to be passed to said application service provider server during said resource request (column 2, lines 30-36).

-In regard to dependent claim 6, Brown teaches wherein said dynamic information was passed to said application service provider using a query string (column 2, lines 32-36).

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-In regard to dependent claim 7, Brown teaches wherein said dynamic information was passed to said application service provider using a cookie (equivalent to passing the provider identifier and user query to the application service provider)(column 2, lines 33-36).

-In regard to dependent claim 8, Brown teaches wherein said hosted application service information (documents and URL's) was determined in response to said dynamic information (column 2, lines 36-42).

-In regard to dependent claim 9, Brown teaches wherein said application service information comprises a link (documents or URL's to documents)(column 2, lines 36-42) to a document residing on said customer server.

-In regard to dependent claim 10, Brown teaches wherein said link was coded so as to preserve dynamic information by including the provider identifier (column 2, lines 34-40).

-In regard to dependent claim 11, Brown teaches wherein said link was coded so as to preserve information using session variables by including the session variable provider identifier (column 2, lines 34-40).

-In regard to dependent claim 17, Brown teaches wherein said hosted application service information comprises a second instruction that retrieves new hosted service

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(column 2, lines 10-15).

information (a second hosted search) from an application service providers server and integrates said new information into said customer document (Fig. 12A: 89) at said user location (columns 9 & 10, lines 67 & 1-2).

In regard to dependent claim 19, Brown teaches wherein said document is an HTML web page (columns 8 & 10, lines 3-5 & 10-32) that does not reside on the application service provider server (column 2, lines 10-12) and said user location comprises a browser (column 8, lines 3-8).

In regard to dependent claim 20, Brown teaches wherein said instruction directs dynamic information (user query and provider identifier) to be passed to said application service provider during said resource request (column 2, lines 32-39) and said hosted application service information was determined in response to said dynamic information (column 2, lines 39-43).

-In regard to independent claim 23, Brown teaches a business method providing: providing an administrative interface via a computer network (Fig. 6A-1-2 & Fig. 6B-1-2); providing, via said administrative interface, an instruction (code) to be embedded in a customer document (column 2, lines 25-28), and providing a hosted service (site-specific searching) in response to said instruction

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-In regard to dependent claim 24, Brown teaches wherein said instruction (code)(column 2, lines 25-28) retrieves hosted service information (search capabilities) from an application service provider server (host computer system)(Fig. 9: 66) and integrates said information into said customer document at the user location (Fig. 8: 61).

-In regard to dependent claim 25, Brown teaches the interface (Fig. 6A-1 & 6A-2) comprises tools adapted to customize the appearance of said information within said customer document by limiting the scope of the search and indexing of the registered documents (Fig. 6B-1 & 6B-2) as well as providing the instruction to be embedded at any user location in the customer document (columns 2 & 10, lines 25-28 & 132)(Fig. 7 & 8:61).

-In regard to dependent claim 26, Brown teaches wherein said interface comprises a customer account enrollment form (column 6, lines 14-21)(Fig. 6A-1 & 6A-2).

-In regard to dependent claim 27, Brown teaches wherein said hosted application service comprises a hosted site search engine (column 2, lines 10-15)(Fig. 8: 61).

-In regard to dependent claim 28, Brown teaches wherein said business method further comprises the step of providing a robot to index a customer web site (columns 2 and 6, lines 21-24 & 55-58)(Fig. 3: 35).

-In regard to independent claim 29, Brown teaches a business method comprising:

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providing, upon request of a user for a web page (column 8, lines 3-8), hosted application service information from a remote location (column 2, lines 10-15), said information being integrated into a customer document at a user location (column 2, lines 25-28) such that it appears to the user that the information came from a network document of said customer (column 2, 29-42)(Fig. 8: 61 & 12A-C).

Claim Rejections - 35 USC § 103

- 8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 9. Claims 12-16 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al (US: 6,336,116 01/01/02).

-In regard to dependent claims 12 and 21, Brown teaches wherein the provider identifier preserved the session information in the form of a web cookie (column 2, lines 33-36) as taught above in claims 7 and 11. Web cookies are well known in the art to provide data persistent session variables such as a user profile or preferences between a user's browser and a web server. Brown does not teach wherein said link was coded to preserve information using the data persistence technique of URL munging. It would have been obvious to one of ordinary skill in the art at the time of the invention for Brown to have used URL munging to preserve session information, because URL/URI munging, the well known process of storing session identifiers and user variables as part

of a web site's URL, would have reduced the notoriously well known privacy and security concerns regarding the cookie data in Brown. Said concerns, which could result in some web site users disabling cookies on their browsers and disabling the search capabilities in the process, would thus be averted.

-In regard to dependent claim 13, Brown teaches where said instruction was an HTML tag (column 10, lines 10-32).

-In regard to dependent claim 14, Brown teaches wherein the service resource was code (column 10, lines 10-32). Brown does not teach wherein said service resource was a JavaScript file. It would have been obvious to one of ordinary skill in the art at the time of the invention for the service resource of Brown to have been a JavaScript file, because it was notoriously well known in the art that JavaScript was a quicker and simpler language for enhancing Web pages and servers, wherein JavaScript is embedded as a small program (code) in a web page that was interpreted and executed by the Web client to provide increased functionality, which in the case of Brown was the hosted site search engine.

-In regard to dependent claims 15 and 16, Brown teaches wherein said link was a text input (Fig. 8: 61) HTML form (column 10, lines 10-32) for a search engine (column 8, lines 9-11)(Fig. 8: 61).

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-In regard to dependent claim 22, Brown teaches wherein said HTML page (columns 8 & 10, lines 3-5 & 10-32) comprises a link to a document residing on a customer server (column 2, lines 36-42) and said link is coded to preserve dynamic information using the provider identifier as a cookie. Web cookies are well known in the art to provide data persistent session variables such as a user profile or preferences between a user's browser and a web server. As discussed above in claim 12, Brown does not teach wherein said link was coded to preserve information using the data persistence technique of URL munging. It would have been obvious to one of ordinary skill in the art at the time of the invention for Brown to have used URL munging to preserve session information, because URL/URI munging, the well known process of storing session identifiers and user variables as part of a web site's URL, would have reduced the notoriously well known privacy and security concerns regarding the cookie data in Brown. Said concerns, which could result in some web site users disabling cookies on their browsers and disabling the search capabilities in the process, would thus be averted.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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05. 2003/0103007	00 2005	i nompson et an

US: 2003/0163586 08-2003 Schnetzler

US: 6,208,975 03-2001 Bull et al.

Art Unit: 2178

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http://web.archive.org/web/20000303062513/www.picosearch.com/whatpeoplesay.html

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L Basehoar whose telephone number is (703) 305-7212. The examiner can normally be reached on M-F: 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2178

ALB

STEPHEN S. HONG PRIMARY EXAMINER

262/117	09/829,951
APPLICANT:	
John Chad Parry	
FILING DATE:	GROUP:
April 11, 2001	2154
	John Chad Parry FILING DATE:

EXAMINER	cMAP		U.S. F	PATENT DOCUMENTS			
EXAMINER INITIAL	THAU	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE
ALB	AA	6,175,830	Jan. 2001	Maynard	707	5	May 1999
	AB						
	AC						
	AD				DE07		
	AE			·	RECEN	(ED	
	AF					2001	
	AG				Technology Cei	ter 2100	
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EXAMINER INITIAL	DOCUMENT NUMBER		DOCUMENT NUMBER DATE		CLASS	SUB CLASS	TRANSLATION YES NO	
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	AK							

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DC # 6191v2

EXAMINER:	Olam S.	Baseleu	DATE CONSIDERED: 05/19/04
EXAMINER	· Initial if refer	ence is considered, wh	ether or not citation is in conformance with MPEP 609.

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FORM PTO-1449	ATTY, DOCK NO.	SERIAL NO.
	262/117	09/829,951
LIST OF PATENTS AND OTHER ITEMS FOR APPLICANT'S	APPLICANT:	
INFORMATION DISCLOSURE STATEMENT	John Chad Parry	
O P E JO (Use several sheets if necessary)	FILING DATE:	GROUP:
(Use several sheets if necessary)	April 11, 2001	2154

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SPIEWI & 1		OTHER DOCUMENTS CONT. (Including Author, Title, Date, Pertinent Pages, etc.)
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Notice of References Cited

Application/Control No.

09/829,951

Examiner

Adam L Basehoar

Applicant(s)/Patent Under
Reexamination
PARRY, JOHN CHAD

Art Unit
Page 1 of 1

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	В	US-2003/0163586	08-2003	Schnetzler, Steve	709/246
	С	US-6,208,975	03-2001	Bull et al.	705/14
	D	US-6,278,993	08-2001	Kumar et al.	707/3
	E	US-6,725,222	04-2004	Musgrove et al.	707/10
	F	US-6,282,567	08-2001	Finch et al.	709/219
	G	US-6,336,116	01-2002	Brown et al.	707/10
	Ι	US-6,651,065	11-2003	Brown et al.	707/10
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	К	US-			
	L	US-			
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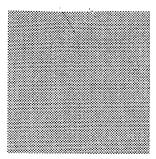
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Hosted solution

Google offers a hosted solution that allows your visitors to conduct web and specialty searches on your site, with the results provided within your own template. Google's search technology runs on our hardware and software so there is no infrastructure investment or time-consuming integration required.

Customizable interface

You can easily customize the look and feel so that your site's search results have a unique appearance. Change the font, the colors, or any aspect of the formatting--you have complete control. And Google's user interface is available in any language.

Regular index updates

All WebSearch licensees receive index updates on a

regular basis to ensure fresh content.

Detailed reporting

Understand your users better by reviewing aggregated daily reports of query volume and top queries. There's no more accurate source of information about your users' interests than their

actual behavioral history.

Targeted advertising

With Google's custom WebSearch, you can sell your own keyword advertising. For example, you could sell a florist ads on pages returned when your

users search for "flowers".

Similar pages For each result, users are able to use Google's

> similar pages technology to find other pages related to that page. Partners can re-brand this feature as

they see appropriate.

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SafeSearch filtering

Google's family filter eliminates search results with inappropriate content. Google offers two versions of this filter: Regular SafeSearch and Strong SafeSearch. Strong SafeSearch blocks a larger set of URLs and applies a stricter interpretation of inappropriate material. To see an implementation of regular SafeSearch, set your preferences on the Google.com website.

Foreign language search

Offer your users the ability to search the web in the language of their choice. Currently, Google offers French, German, Italian, Swedish, Finnish, Spanish, Portuguese, Dutch, Norwegian, Danish, Chinese, Japanese, and Korean. New languages are added with regularity, so contact us for the current list.

Restricted search

For sites with a specific focus, Google can offer a restricted search over a specific set of URLs or over web pages from a specific country. Examples of a search over specific URLs include Google's Linux search, Government search, and Apple search. An example of a search over a specific country's web pages can be seen at Virgin.net, which searches over .uk pages. For a restricted search, you need only specify the URLs you want included in the index.

Vertical search

Google can create a search in a specific vertical area (e.g., computers or travel) without a list of specific URLs. This option makes it easier to ensure your customers only see results related to the topic of your website.

Google Standard Features

Growing index

Google searches over more than a billion pages, the largest search index on the web. And Google's index is continuously scrubbed to eliminate duplicate URLs and dead links.

Host crowding

When results are returned, Google makes sure that they are not all from the same domain. Multiple results from the same location are neatly indented under the first result from that domain.

Patented search algorithm

Google's <u>PageRank technology</u> is the heart of our unique technology. It evaluates the complex link structure of the web to determine which results are most relevant to your user's query.

Snippets

Results listings show fragments of text from each web site found that include the search text. This

h eb ch e g eb

g gec e ce c

h

helps users better predict if that result will answer their question.

WebSearch Support

Google offers 24x7 support to ensure that your search service is always up and running. Google has historically maintained a 99.5% service uptime.

Current Customer List

Google currently licenses its web search to over 75 different partners. Large customers include: <u>Yahoo!</u>, <u>Netscape</u>, <u>Washington Post</u>, and <u>Virgin.net</u>. For a more detailed list of customers, <u>please see our partner page</u>.

WebSearch Pricing

The pricing for Google's WebSearch services is based upon a small license fee and a CPM (cost per thousand results sets delivered). Additional customizations and addon options are extra. For a custom proposal, please contact one of our specialists at websearch@google.com.

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WHAT IS PICOSEARCH?

a search engine to search your web site.

Picosearch.com is a fully professional **Search Hosting™** service that gives you a search engine over the Internet to search your own website or any collection of websites. Whether you are offering search on one site or becoming a mini web portal across many web pages, you will help your visitors find what they're looking for, with the benefit to you of completely controlling where they find it too. So you will never have to lose a potential customer again!

PicosSearch is easy to install, and offers **unlimited searching** with no additional software required. This service is available FREE for popular default settings, or by business-quality subscription services with **full layout control** and advanced account management features.

There is no outside advertising on PicoSearch! Free accounts display the PicoSearch branding, while paid accounts are not required to carry any reference to PicoSearch at all. Paid accounts may also re-sell their own advertising space through clever use of their design templates.

Typically, individuals love the advanced searching power that **PicoSearch Free** brings instantly to any homesite, while businesses and entrepreneurs enjoy the low-cost, nomaintenance approach of the **Professional and Premium Plans**, by which the look-and-feel of the search results pages can be fully integrated into the existing site design for high indexing limits.

Picosearch levels the playing field for web designers by making high-end services available to non-server owners and beginners alike. Thanks to proprietary technologies which have been developed specifically for the Search Hosting concept, PicoSearch offers advanced features like: all search words shown as found in full-context (concordance), multilingual displays, user search statistics, while-you-wait installation, multiple indexer entry points with precise linkfollowing control, high-reliability with on-demand re-indexing, and high indexing limits. For a full list of features see the service plan comparison charts, and don't forget to frequently check our What's New pages too. We are continually bringing advanced new options on line with no disruption to current services, so you'll want to take full advantage of every great feature!

At PicoSearch headquarters, a high-capacity server-farm

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architecture keeps your personal search engine up and running 24 hours a day. Our downtime is less than .01% (which is as good as it gets on the Internet!), and our tech support is exceptional should you ever have any difficulties or suggestions. Special requirements, such as for extra-large sites or custom data sources, are available to fee-based clients from the PicoSearch consulting staff, which is comprised of experts in the fields of hardware, software, and computational linguistics.

Your website can be your best friend. It's loaded with valuable information. Consult it today, with PicoSearch!

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"No major website can do without a search utility.

Search utilities make it

much easier for visitors to find specific information. But building a search engine is way beyond most Web builder's skill sets. The text on the site has to be indexed, and a query has to be built that allows people to drop in keywords and come up with results.

Fortunately, (PicoSearch will) let you add search functions to your site without a lot of hassle... To show you how easy it is, we'll walk you through adding a free PicoSearch to your site. While other options require you to install some software on your server, you can set up PicoSearch on any site, no matter who's hosting it."

Ann Hudspeth -- "*Great service!* I got there through CNet's Web Builder Dispatch and in less than 15 minutes I had a search engine up and running on my website! Great!"

Ed Schneider in Arizona -- "An Excellent and Easily Useable Search Utility! I wish to thank you for the very courteous and prompt service. Your service is EXACTLY what we have been looking for and I am sure will provide a superb addition to our sites. I am a newspaper columnist here in Arizona and, because your service is so unique and your tech support so good, I will do whatever I can to promote the use of your service. Again I compliment you on an excellent and easily useable search utility."

ZDNet PCComputing

PC/Computing -- October, 1999
"There's nothing worse than
searching a Website for some

nugget of information and coming up empty-handed. Make sure your customers find what they're looking for... PicoSearch makes your entire site searchable by keyword so visitors can zoom in on what they need."

Mark Zirinsky -- "Great product! Our website has grown so large that even though I wrote it, I can't find stuff on it, much less our customers. Thank you for your time and attention."

Scott Ventura -- "I was very excited to hear about PicoSearch. I've been looking to add search to my site for a while, but not been able to find an external search hoster. **THANKS!**"

Mike Lastucka -- "You guys have no idea how long I've been searching for a good free search engine such as yours ... unobtrusive and professionally styled, **very cool service!**"

Aaron in Ontario -- "I wanted to drop you a line to tell you how thoroughly impressed I am with your service. It is fast and professional. **Installation and maintenance is a breeze**. Plus, the top 20 keyword search list is indispensable.

As I only have a fun site, the free service is perfect for me. But when I do launch my commercial site, I know where I am going to come to purchase my site search engine service."

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